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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/998,002

11/30/2001

Warren S. Slutter

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22045 7590 11/03/2010

BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER

LAUCHMAN, LAYLA G

ART UNIT

PAPER NUMBER

2877

MAIL DATE

DELIVERY MODE

11/03/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/998,002	Applicant(s) SLUTTER ET AL.	
	Examiner L. G. Lauchman	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7,8,10-12 and 84-130 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 125-128 is/are allowed.
- 6) ☐ Claim(s) 1-12,84-105,121-124,129 and 130 is/are rejected.
- 7) ☐ Claim(s) 106-110, 111,112-116,117-120 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

The finality of that action filed on 5/20/2010 is withdrawn. However, in view of the improper marking of claims and the issue of the surrender and recapture of claims 1, 66, and 129, the new rejection is made. The allowability of claims 1, 7, 8, 10-12, 66, 84-124, 129 and 130, indicated in the Office action mailed on 5/20/2010, has been withdrawn.

The amendment filed on 4/14/09 is improper since all the subject matter being added to an original patent claim must be underlined and all subject matter being deleted from an original patent claim must be placed between brackets, and all the marking should be made relative to the patented claims (see 37 CFR 1.173(b)(2) and (d) and (g), MPEP 1453.II). Thus the format of claims 7, 8, 10-12, 66 should be corrected to show proper markings to the original patent claims. The format of claims 84-97, 99-110, 112-120 should be corrected to show the proper markings (i.e., underlined without brackets, since the claims have been added to the patented claims). In the amendment filed on 12/09/09, Claims 1, 98, 121-130 are in proper format, however, Claim 111 remains improper. There should be no markings on page 4 (amendment to claims filed on 12/09/09), line 2, after “toward”). The applicant is advised to send a complete list of claims in a proper format, and

Claims 1, 66 and 129 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed.

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Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The independent Claims 1, 66, and 129 intend to broaden the patented claims 1 and 66 by deleting the language at issue "for receiving an order of light that maximizes throughput and minimizes astigmatism."

From the prosecution record of the original application 08/884,447, the examiner rejected claim under 35 USC 103 (a) as being unpatentable over the Prior Art cited by the Applicant in view of Schwenker and Thevenon and Claim 66 was rejected under 102 (b) as being anticipated by Nishi (see Non-Final Office Action mailed on 10/27/98).

In response to the examiner's rejection, the applicant amended the independent claims to add the following underlined limitation "*a primary exit port being located substantially out of said meridian plane toward said second side for providing a substantially anastigmatic flat field image near said primary exit port over a spectral range.*" and further argued that the Prior Art does not show or suggest the modified primary exit ports (see in 08/884,447, Applicant's remarks filed on 2/1/99, pages 17-27)

In the Final Office Action mailed on 4/27/99, in response to the applicant's argument, the examiner indicated the allowable subject matter of claims 1 and 66, if rewritten or amended to overcome the rejection under 35 USC 112, 1st paragraph.

In the Amendment filed on 6/11/99 (see pages 1, 2, and 9), in order to overcome the 112 rejection, the applicant amended claims 1 and 66 by replacing the phrase “*providing a substantially anastigmatic flat field image near said primary exit port over a spectral range*” with the phrase -- *receiving an order of light that maximizes throughput and minimizes astigmatism* --.

Thus, the deleted limitation at issue “*receiving an order of light that maximizes throughput and minimizes astigmatism*” was surrendered in the original application.

Allowable Subject Matter

Claims 125-128 are allowed. The allowable subject is indicated in the office action mailed on 5/20/2010.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to L. G. Lauchman whose telephone number is (571) 272-2418. The examiner's normal work schedule is 8:00am to 4:30pm (EST), Monday through Friday. If attempts to reach examiner by the telephone are unsuccessful, the examiner's supervisor Gregory J. Toatley, Jr. can be reached on (571) 272-2059, ext. 77.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)?

Any inquiry of a general nature or relating to the status of this application should be directed to the TC receptionist whose telephone number is (571) 272-1562.

/L. G. Lauchman/
Primary Examiner, Art Unit 2877

11/1/2010